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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/801,741

03/16/2004

Jay F. Kunzler

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1847

23702

7590

10/06/2006

Bausch & Lomb Incorporated  
One Bausch & Lomb Place  
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EXAMINER

NWAONICHA, CHUKWUMA O

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/801,741

Applicant(s)

KUNZLER ET AL.

Examiner

Chukwuma O. Nwaonicha

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Current Status***

1. This action is responsive to Applicants' amendment of 3 March 2004.
2. Claims 17-29 are pending in the application.

### ***Priority***

Applicants' claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Refojo et al., {US 5,336,487}.

Applicants claim a method of using a tamponade in an ophthalmic surgical procedure comprising: creating an incision into a posterior chamber of an eye; and filling

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said posterior chamber of the eye with said silicone oil made by a process of performing a supercritical carbon dioxide extraction of said silicone oil or fluid to remove cyclic and oligomeric impurities, wherein all the other variables are as defined in the claims.

**Determination of the scope and content of the prior art (M.P.E.P. §2141.01)**

Refojo et al. teach a process of treating an intraocular structural disorder of an eye comprising introducing into the intraocular structure under treatment a liquid silicone /fluorosilicone copolymer oil in an amount effective to treat the intraocular structural disorder. See the specification.

**Ascertainment of the difference between the prior art and the claims (M.P.E.P.. §2141.02)**

Refojo et al. method of using a tamponade in an ophthalmic surgical differs from the instantly claimed process in that applicants claim a process wherein posterior chamber of the eye is filled with silicone oil made by a process of performing a supercritical carbon dioxide while Refojo et al. is silent about how the silicone oil or fluid was made.

**Finding of prima facie obviousness--rational and motivation (M.P.E.P.. §2142-2143)**

The instantly claimed method of using a tamponade in an ophthalmic surgical process would have been suggested to one of ordinary skill because one of ordinary skill wishing to perform ophthalmic surgical process is taught to employ the process of Refojo et al.

One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by treating an intraocular structural disorder of an eye comprising introducing into the intraocular structure under treatment a liquid silicone /fluorosilicone copolymer oil in an amount effective to treat the intraocular structural disorder by following the teaching of Refojo et al. to arrive at the instantly claimed ophthalmic surgical process with tamponade. Said person would have been motivated to practice the teaching of the reference cited because it demonstrates that tamponade is a useful medical material for treating eye disorder. The Examiner did not give any patentable weight to the process step in which the silicone oil or fluid was made. Therefore, the instantly claimed invention would therefore have been obvious to one of ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman k. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit: 1621

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